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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,925	04/09/2001	Hiroshi Kajiwara	35.C12124 REI	5185

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EXAMINER	
CHEN, WENPENG	
ART UNIT	**PAPER NUMBER**
2624	

DATE MAILED: 04/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/827,925	KAJIWARA, HIROSHI	
	Examiner	Art Unit	
	Wenpeng Chen	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *4/19/2002, 12/16/2002*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *9-13* is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: *See Continuation Sheet*.

Continuation of Attachment(s) 6). Other: This also is responsive to PTO internal review, the intervew on 1/24/2003 and suplemental submission filed on 1/23/2003.

Remarks

1. After reviewing this reissue application with SPRE Zele, the Examiner vacates the Quayle Action (paper #7) mailed on 7/15/2002. The reasons are given below.

2. SPRE Zele made an interview with Mr. Raymond DiPerna on 1/24/2003 indicating withdrawal of the Quayle Action due to (1) a problem of improper recapture of the pending Claims 1-8 and (2) the need of a new Written Consent of Assignee.

3. A corrected 3.73(b) statement and corrected Consent of Assignee have been received on 1/23/2003 and entered as paper #10. The statement and Consent overcome the objection set forth in paper #5.

4. In July 2003, SPRE Zele discussed with Mr. Raymond DiPerna about a tentative proposed approach with a supplemental declaration and proposed amendments to Claims 1, 7, and 8 to overcome the problem. On 10/30/2003, Examiner Chen called Mr. DiPerna for follow-up of the supplemental declaration and the proposed amendments. As of today, USPTO has not received the official supplemental declaration and proposed amendments. Therefore, this Office Action is being prepared to vacate the Quayle Action.

Claim Rejections

5. Claims 1-8 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc.* v. *Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement,* 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp.* v. *United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

In the original application 08/874,581, the Examiner provides the following reasons for allowance for Claims 18, 24, and 25 of the original application, which were renumbered as Claims 1, 7, and 8 in the issued patent 6,028,963.

"The prior art fails to teach apparatus of Claim 18, method of Claim 24, and medium of Claim 25 which specifically comprise the limitations of:

-- judging an appearing prediction error difference and an unappearing prediction error difference on the basis of the first prediction error difference, and for encoding the second prediction error difference on the basis of the judged appearing and unappearing prediction error differences, wherein the second prediction error difference is not used in the judging operation;

-- changing a first relationship between prediction error difference and encoding data to a second corresponding relationship between prediction error difference and encoding data according to a result obtained in the judging operation."

In the above reason of allowance of the original application, the Examiner specifically pointed out that the combination of the two listed limitations, *each in whole not in part*, distinguishes the original Claims 18, 24, and 25 over the teachings of the prior art. Applicant did not present on the record a counter statement or comment as to the Examiner's reasons for allowance, and permitted the claims to issue. The omitted limitation is thus established as relating to subject matter previously surrendered.

Therefore, independent Claims 1, 7, 8 and dependent Claims 2-6 of the reissue application are rejected as being an improper recapture.

6. Responses to Applicant's argument in paper #6

a. Applicant's argument-- The Applicants argued that amended Claims 1, 7, and 8 in this reissued application are not broader than Claims 1, 7, and 8 of the original issued patent 6,028,963. For example, the limitation "encoding the second prediction error difference on the basis of the judged appearing and unappearing prediction error differences" recited in judging means of the original Claim 1 is in effect redundant of the limitation "encoding the second prediction error difference on the basis of a selected one of the first and second corresponding relationships to obtain corresponding encoding data" recited in the encoding means. Both the encoding apparatuses of Claim 1 of the reissue application and Claim 1 of US Patent 6,028,963 perform essentially the same way.

Examiner's response -- The Examiner disagrees that these two Claim 1 are of the same scope. The differences between the encoding apparatuses of Claim 1 of the reissue application

and Claim 1 of US Patent 6,028,963 are tabulated below. The highlight and the numerals are added by the Examiner for convenience of discussion.

Claim 1 of the reissue application	Claim 1 of US Patent 6,028,963
judging means for judging an appearing prediction error difference and an unappearing prediction error difference on the basis of the first prediction error difference, wherein the second prediction error difference is not used in the judging operation	judging means for judging an appearing prediction error difference and an unappearing prediction error difference on the basis of the first prediction error difference, **and (1) for encoding the second prediction error difference on the basis of the judged appearing and unappearing prediction error differences**, wherein the second prediction error difference is not used in the judging operation
changing means for changing a first corresponding relationship between prediction error difference and encoding data to a second corresponding relationship between prediction error difference and encoding data according (4) *to a result obtained by said judging means*	changing means for changing a first corresponding relationship between prediction error difference and encoding data to a second corresponding relationship between prediction error difference and encoding data according *to (2) a result obtained by said judging means*
encoding means for encoding the second prediction error difference (5) *on the basis of one of the first and second corresponding relationships* to obtain corresponding encoding data	encoding means for encoding the second prediction error difference (3) *on the basis of* **a selected** *one of the first and second corresponding relationships* to obtain corresponding encoding data

In Claim 1 of US Patent 6,028,963, because the combination of items (1) and (2) above, the second prediction error difference is encoded based on item (3) and also based on "**the judged appearing and unappearing prediction error differences.**"

For Claim 1 of the reissue application, the limitation of item (1) is deleted from the judging means and the result recited in item (4) above is not inherently or implicitly limited by

item (1) above. As a consequence, the second prediction error difference is not necessary to be encoded based on **"the judged appearing and unappearing prediction error differences" because the relationships is selected based on a "non-defined" result recited in item (4).**

Therefore, the scope of Claim 1 of the reissue application is broader than that of Claim 1 of US Patent 6,028,963.

Similar responses are also applied to Claims 7 and 8.

b. Applicant's argument -- In application 08/874,581 (application of US Patent 6,028,963,) Applicant did not, and could not have surrendered the subject matter at issue, since the mentioned encoding means/steps of Claims 1, 7, and 8 of US Patent 6,028,963, which reads on the subject matter, never was amended, canceled, or argued in the original application to overcome a rejection or objection in that application.

Examiner's response -- The Examiner does not agree with the above conclusion. The issued Claims 1, 7, and 8 of US Patent 6,028,963 are originally numbered as Claims 18, 24, and 25, respectively. In the original application, the Examiner rejected the original Claims 1-17 based on Weinberger et al. (US patent 5,680,129.) In response, Applicant canceled Claims 1-17 and added new Claims 18-30. As shown in the file of application 08/874,581, Claims 18, 24, and 25 correspond to the canceled Claims 1, 7, and 17, but with further limitations of the generation, judgment, and entropy encode means/step recited in the canceled Claims 1, 7, and 17. In Claim 18, 24, and 25, the entropy encode means/step is further divided into narrower changing and encoding means/step. Although Claims 18, 24, and 25 have not been amended, they themselves are the rewritten narrow-scope versions of Claims 1, 7, and 17, respectively, presented

previously in the original application. Therefore, Claims 18, 24, and 25 are considered as being amended from Claims 1, 7, and 17.

Furthermore, in pages 15-16 of Applicant's Amendment filed on 6/21/1999 of application 08/874,581, Applicant argued that although Claims 1, 7, and 17 can be rejected based on Weinberger, the added (equivalently amended) Claims 18, 24, and 25 overcome the rejection because Weinberger does not teach the recited relationship. As pointed out by Applicant in page 15 of the Amendment, change of the recited relationship is made according to the judgment of appearing and unappearing prediction error differences. ***Evidently, Applicant did make amendments related to the issued Claims 1, 7, and 8 in the original application to overcome a rejection based on Weinberger in that application.***

Examiner's Statement of Reasons for Allowance

7. Claims 9-13 are allowed.

The examiner's statement of reasons for allowance has been given in paper #5.

Conclusion

8. THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). The Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). As discussed above, the Examiner does not change his ground of rejection set forth in paper #5.

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wenpeng Chen whose telephone number is 703 306-2796. The examiner can normally be reached on 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K Moore can be reached on 703 308-7452. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9306 for After Final communications. TC 2600's customer service number is 703-306-0377.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-4700.

Wenpeng Chen
Examiner
Art Unit 2624

April 8, 2004